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Attorney Docket No. 1419.1061C

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Yousuke YONEDA

Application No.: 10/671,601

Group Art Unit: Unassigned

Filed: September 29, 2003

Examiner: Unassigned

For: SUSPENSION FOR RUNNING TOY AND RUNNING TOY

INFORMATION DISCLOSURE STATEMENT

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

In accordance with the duty of disclosure provisions of 37 CFR § 1.56, there is hereby provided certain information which the Examiner may consider material to the examination of the subject U.S. patent application. It is requested that the Examiner make this information of record if it is deemed material to the examination of the subject application.

1. Enclosures accompanying this Information Disclosure Statement are:

- 1a. ☒ Form PTO-1449.
- 1b. ☒ Copies of IDS citations.
- 1c. ☐ An English language copy of search report(s) from a counterpart foreign application or a PCT International Search Report.
- 1d. ☒ English language translation (complete or relevant portion(s)) attached to each non-English language publication.
- 1e. ☐ Explanations of Relevancy of References (ATTACHMENT 1(e), hereto) for providing a concise explanation of each non-English publication.
- 1f. ☐ List of Copending Applications (ATTACHMENT 1(f), hereto).
- 1g. ☐ List of Additional Submitted Documents (ATTACHMENT 1(g), hereto).

2. ☐ This Information Disclosure Statement is filed under 37 CFR §1.97(b):

(Check either Item 2a or 2b or 2c or 2d)

- 2a. ☐ Within three months of the filing date of a national application other than a Continued Prosecution Application under § 1.53(d);
- 2b. ☐ Within three months of the date of entry of the national stage as set forth in § 1.491 in an international application.
- 2c. ☒ Before the mailing of a first Office Action on the merits; or
- 2d. ☐ Before the mailing of a first Office Action after the filing of a Request for Continued Examination under § 1.114.

3. ☐ This Information Disclosure Statement is filed under 37 CFR § 1.97(c) after the period specified in paragraph 2 above but before the mailing date of any of a Final Office Action under § 1.113, a Notice of Allowance under § 1.311 or an action that otherwise closes prosecution in the application, AND

(Check either Item 3a or 3b; Item 3b to be checked if any reference known for more than 3 months)

- 3a. ☐ The § 1.97(e) Statement in Item 5 below is applicable; OR
3b. ☐ The \$180.00 fee set forth in 37 C.F.R. § 1.17(p) is:
☐ enclosed.
☐ to be charged to Deposit Account No. 19-3935.

4. ☐ This Information Disclosure Statement is filed under 37 CFR § 1.97(d) after the period specified in paragraph 3 above, but on or before payment of the Issue Fee, AND

- 4a. ☐ The § 1.97(e) Statement in Item 5 below is applicable; AND
4b. ☐ The \$180.00 fee set forth in 37 C.F.R. § 1.17(p) is:
☐ enclosed.
☐ to be charged to Deposit Account No. 19-3935.

5. ☐ Statement under § 1.97(e) (*applicable if Item 3a or Item 4a is checked*)

(Check either Item 5a or 5b)

- 5a. ☐ In accordance with 37 CFR § 1.97(e)(1), it is stated that each item of information contained in this Information Disclosure Statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this Information Disclosure Statement.
5b. ☐ In accordance with 37 CFR § 1.97(e)(2), it is stated that no item of information contained in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application and, to the knowledge of the person signing the certification after making reasonable inquiry, no item of information contained in this Information Disclosure Statement was known by any individual designated in § 1.56(c) more than three months prior to the filing of this Information Disclosure Statement.

6. ☐ This is a continuation/divisional/continuation-in-part application under 37 CFR § 1.53(b).

(Check appropriate Items 6a and/or 6b)

- 6a. ☐ Copies of the publications listed on the attached Form PTO-1449 which were previously cited in prior application Serial No. ___, filed on ___, and which is relied on for an earlier effective filing date for the subject application under 35 U.S.C. § 120, have been omitted pursuant to 37 CFR § 1.98(d).
6b. ☐ Copies of the publications listed on the attached Form PTO-1449 which were not previously cited in prior application Serial No. ___, filed on ___, and which is relied on for an earlier effective filing date for the subject application under 35 U.S.C. § 120, are provided herewith.

7. ☐ This is a continuation/divisional application under 37 CFR § 1.53(d) or a Request for Continued Examination under 37 CFR 1.114.
(Check either Item 7a or 7b)
- 7a. ☐ The Issue Fee has not been paid.
- 7b. ☐ A Petition to Withdraw from issue under 37 CFR § 1.313(c) is filed concurrently herewith or has been granted. A continuation/divisional application under 37 CFR § 1.53(d) or a Request for Continued Examination under 37 CFR 1.114, after payment of the Issue Fee, is proper in accordance with 37 CFR § 1.53(d)(1)(ii) or 37 CFR 1.114(a), respectively.
8. ☐ This is a Supplemental Information Disclosure Statement.
(Check either Item 8a or 8b)
- 8a. ☐ This Supplemental Information Disclosure Statement under 37 CFR § 1.97(f) supplements the Information Disclosure Statement filed on _____. A bona fide attempt was made to comply with 37 CFR § 1.98, but inadvertent omissions were made. These omissions have been corrected herein. Accordingly, additional time is requested so that this Supplemental IDS can be considered as if properly filed on _____.
- 8b. ☐ This Supplemental Information Disclosure Statement is timely filed within one (1) month of the Notice under 37 CFR § 1.97 and 1.98, mailed _____.
9. ☒ In accordance with 37 CFR § 1.98, a concise explanation of what is presently understood to be the relevance of each non-English language publication is:
(Check appropriate Items 9a, 9b, 9c and/or 9d)
- 9a. ☐ satisfied because all non-English language publications were cited on the enclosed "English language version of the search report or action which indicates the degree of relevance found by the foreign office". (See MPEP § 609, Minimum Requirements for an Information Disclosure Statement, Part A(3): Concise Explanation of Relevance, 8th Ed.)
- 9b. ☐ set forth in the application.
- 9c. ☒ satisfied because an English language translation (complete or relevant portion(s)) is attached to each non-English language publication.
- 9d. ☐ enclosed as Attachment 1(e), hereto.
10. No admission is made that the information cited in this Statement is, or is considered to be, material to patentability nor a representation that a search has been made (other than search report(s) from a counterpart foreign application or a PCT International Search Report, if submitted herewith). 37 CFR §§ 1.97(g) and (h).

11. The Commissioner is authorized to credit any overpayment or charge any additional fee required under 37 CFR § 1.17 for this Information Disclosure Statement to Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Dated: _____
1201 New York Ave., N.W., Suite 700
Washington, D.C. 20005
Telephone: (202) 434-1500
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By: 
William F. Herbert
Registration No. 31,024



Sheet 1 of 1

FORM PTO-1449	U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE	ATTORNEY DOCKET NO. 1419.1061C	APPLICATION NO. 10/671,601
LIST OF REFERENCES CITED BY APPLICANT (Use several sheets if necessary)		FIRST NAMED INVENTOR Yousuke YONEDA	
		FILING DATE September 29, 2004	GROUP ART UNIT Unassigned

U.S. PATENT DOCUMENTS

*EXAMINER INITIAL		DOCUMENT NO.	DATE	NAME	CLASS	SUB- CLASS	FILING DATE
	A	3,939,605	2/24/76	Allen			

FOREIGN PATENT DOCUMENTS

		DOCUMENT NO.	DATE	COUNTRY	CLASS	SUB- CLASS	TRANSLATION YES NO	
	B	1,095,490	12/20/67	Great Britain ¹				

OTHER REFERENCES (Including Author, Title, Date, Pertinent Pages, Etc.)

							TRANSLATION YES NO	
	C	Japanese Reference No. 1-172894, the inventor of which is identified as "Yoshio Minato", but actually the translation of the inventor's name is "Yoshio Suimon", dated December 7, 1989					X	
	D	Japanese Reference No. 38-16765, the inventor of which is Michio Sakai, dated August 10, 1963					X	
	E	Japanese Reference No. 61-002884, the inventor of which is Kiyoshi Kumazawa, dated January 8, 1986					X	
	F	Reexamination Request filed in parent, now U.S. Patent No. 6,656,011, copy attached. Now Inter Partes Reexam. Control No. 95/000,0036						

EXAMINER	DATE CONSIDERED
*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.	
1. Already of Record.	



Attorney Docket No. 2030.87
Customer No. 27683

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Request for <i>Inter Partes</i> Reexamination	§	
	§	
U.S. Patent No. 6,656,011	§	REQUEST FOR <i>INTER PARTES</i>
	§	REEXAMINATION
Issued: December 2, 2003	§	
	§	
For: SUSPENSION FOR RUNNING TOY	§	Attorney Docket No: 2030.87
AND RUNNING TOY	§	
	§	
Requestor: RadioShack Corporation	§	Customer No.: 27683

TRANSMITTAL FOR REQUEST FOR *INTER PARTES*
REEXAMINATION UNDER 35 U.S.C. §§ 311-318

Mail Stop Inter Partes Reexam
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

1. This is a request for reexamination of U.S. Patent No. 6,656,011 ('011 patent) pursuant to 37 C.F.R. § 1.915.
2. The name and address of the reexamination requestor is: RadioShack Corporation, 100 Throckmorton, Suite 1700, Fort Worth, Texas, 76102.
3. Pursuant to 37 C.F.R. § 1.915(a), a check in the amount of \$8,800.00 is enclosed for the fee due as prescribed under 37 C.F.R. § 1.20(c)(2).
4. The attached Request for Reexamination includes the following items:
 - a. An identification of the patent by patent number and every claim for which reexamination is requested. 37 C.F.R. § 1.915(b)(1).
 - b. A citation of the patents and printed publications which are presented to provide a substantial new question of patentability. 37 C.F.R. § 1.915(b)(2).
 - c. A statement pointing out each substantial new question of patentability based on the cited patents and printed publications, and a detailed explanation of the pertinency and manner of applying the patents and printed publications to every claim for which reexamination is requested. 37 C.F.R. § 1.915(b)(3).
 - d. A copy of every patent or printed publication relied upon or referred to in paragraphs (b)(1) through (3) of this section, accompanied by an English language translation of all the necessary and pertinent parts of any non-English language document. 37 C.F.R. § 1.915(b)(4).

- e. A copy of the entire patent including the front face, drawings, and specification/claims (in double column format) for which reexamination is requested, and a copy of any disclaimer, certificate of correction, or reexamination certificate issued in the patent. 37 C.F.R. § 1.915(b)(5).
- f. A certification by the third party requester (RadioShack Corporation) that a copy of the request has been served in its entirety on the patent owner at the address provided for in § 1.33(c). 37 C.F.R. § 1.915(b)(6).
- g. A certification by the third party requester that the estoppel provisions of § 1.907 do not prohibit the *inter partes* reexamination. 37 C.F.R. § 1.915(b)(7).
- h. A statement identifying the real party in interest to the extent necessary for a subsequent person filing an *inter partes* reexamination request to determine whether that person is a privy. 37 C.F.R. § 1.915(b)(8).

5. Reexamination of claims 1-12 of U.S. Patent No. 6,656,011 is hereby requested.

The Commissioner is hereby authorized to charge payment of any further fees associated with any of the papers submitted herewith or to credit any overpayment to Deposit Account No. 08-1394.

If the Examiner has any questions concerning the Request for Reexamination, please telephone the undersigned at (214) 651-5533.

Respectfully submitted,



David L. McCombs
Registration No.: 32,271

Date: 23 FEBRUARY 2004
HAYNES AND BOONE, LLP
901 Main Street, Suite 3100
Dallas, Texas 75202
Phone: (214) 651-5533
Fax: (214) 200-0853
File No.: 2030.87
D-1215571_1.DOC

EXPRESS MAIL NO.: _____

DATE OF DEPOSIT: _____

This paper and fee are being deposited with the U.S. Postal Service Express Mail Post Office to Addressee service under 37 CFR §1.10 on the date indicated above and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

Name of person mailing paper and fee

Signature of person mailing paper and fee

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Request for <i>Inter Partes</i> Reexamination	§	
	§	
U.S. Patent No. 6,656,011	§	REQUEST FOR <i>INTER PARTES</i>
	§	REEXAMINATION
Issued: December 2, 2003	§	
	§	
For: SUSPENSION FOR RUNNING TOY	§	Attorney Docket No: 2030.87
AND RUNNING TOY	§	
	§	Customer No.: 27683
Requestor: RadioShack Corporation	§	

REQUEST FOR *INTER PARTES* REEXAMINATION UNDER 35 U.S.C. §§ 311-318

Mail Stop Inter Partes Reexam
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Pursuant to the provisions of 35 U.S.C. §§ 311-318, the undersigned, on behalf of RadioShack Corporation, the real party in interest, hereby requests an *inter partes* reexamination of United States Patent No. 6,656,011 (the '011 patent) that issued on December 2, 2003 to Yousuke Yoneda resulting from a patent application filed on January 28, 2002. In accordance with 37 C.F.R. § 1.915(b)(5), a copy of the '011 patent is attached hereto as *Exhibit A*. In accordance with 37 C.F.R. § 1.915(b)(7), RadioShack Corporation hereby certifies that the estoppel provisions of 37 C.F.R. § 1.907 do not prohibit this request for *inter partes* reexamination.

I. Citation of Claims for which Reexamination is Requested and Citation of Patents and Printed Publications Presented to Provide a Substantial New Question of Patentability

In accordance with 37 C.F.R. §§ 1.915(b)(1) and (b)(2), reexamination of claims 1-12 of the '011 patent is requested in view of the following references:

- (1) Japanese Laid-Open Utility Model Application Number 1-172894 to Minato ("Minato '894"), published on December 7, 1989, and enclosed as *Exhibit B*; and
- (2) Japanese Utility Model Application Number 38-16765 to Sakai ("Sakai '765"), published on August 10, 1963, and enclosed as *Exhibit C*.
- (3) Japanese Patent Laid-Open Publication Number S61-002884 to Kumazawa ("Kumazawa '884"), published on January 8, 1986, and enclosed as *Exhibit D*.

- (4) Great Britain Patent Number 1095490 to Perryman ("Perryman '490"), published on December 20, 1967, and enclosed as *Exhibit E*.
- (5) United States Patent Number 3,939,605 to Allen ("Allen '605"), published on February 24, 1976, and enclosed as *Exhibit F*.

II. The Disclosure of the '011 Patent

The '011 patent discloses, *inter alia*, a suspension system for radio-controlled toy cars. *Col. 1, lines 7-11, figs. 11-16.*

In relevant part, the '011 patent describes a suspension system composed of an elastic leaf spring 30, which is disposed on an upper chassis 2f of a toy car. *Col. 7, lines 18-21, figs. 11-12.* The leaf spring 30 includes a U-shaped curve at a middle portion thereof, and is slightly held on the upper chassis 2f at the curve by a shaft 41 provided on the upper chassis 2f. *Col. 7, lines 21-23, figs. 11-12.*

The leaf spring 30 is arranged on the upper chassis 2f to abut against shafts 21b, which pass through hole portions of the upper chassis and a lower chassis 2e. *Col. 7, lines 24-27, figs. 11-12.* The shafts 21b form a portion of right and left turning members 21, which hold the front wheels (not shown). *Col. 6, lines 1-12, figs. 11-12.* Thus, the leaf spring 30 acts to bias against the shafts 21b to cushion shock experienced by the wheels and to ground the wheels with a surface. *Col. 7, lines 35-39, figs. 11-12.*

The '011 patent describes another embodiment of the suspension system, which is similar to the foregoing suspension system except that a leaf spring 50 is unitedly formed with a shaft 51. *Col. 7, lines 40-45, fig. 13.*

The '011 patent describes yet another embodiment of a suspension system in which a wheel shaft 21a is provided to connect right and left wheels 2c. *Col. 7, lines 49-52, figs. 14-15.* Notches are formed in the side walls of the chassis 2 to accommodate vertical movement of the wheel shaft 21a. *Col. 7, lines 52-57, figs. 14-15.* An elastically deformable biasing member 60 is further provided to contact the wheel shaft 21a at a middle of the wheel shaft. *Col. 7, lines 58-63, figs. 14-15.* Accordingly, the wheel shaft 21a can perform a seesaw motion by using a contact portion 61 with the biasing member 60 as a fulcrum. *Col. 7, lines 63-66, figs. 14-15.* Thus, elastic deformation of the biasing member 60 provides a biasing force to properly ground right and left wheels 2c to a road surface. *Col. 8, lines 1-7, figs. 14-15.*

III. Claims 1-12 of the '011 Patent

Claims 1-12 of the '011 patent include the following elements:

Claim Element	Claims 1-12 of the '011 Patent											
	1	2	3	4	5	6	7	8	9	10	11	12
right and left turning members which turn right and left wheels in horizontally clockwise and counterclockwise directions around right and left shafts, respectively	✓	✓	✓	✓	✓	✓	✓					
a connecting member which connects the right and left turning members with each other, and which forms a turning pair with each of the right and left turning members	✓	✓	✓	✓	✓	✓	✓					
a leaf spring which is located on an upper surface of an upper chassis, a middle portion of the leaf spring in a width direction being supported by the upper chassis	✓	✓	✓	✓	✓	✓	✓					
wherein the right and left turning members are located between and supported by the upper chassis and a lower chassis to be slightly movable therebetween so that upper portions and lower portions of the right and left shafts are loosely inserted into hole portions formed in the upper and lower chassis, respectively, and top ends of the upper portions of the right and left shafts project vertically from the upper surface of the upper chassis through the hole portions thereof and are in contact with a lower surface of the leaf spring to be subjected to a downward biasing force caused by elastically deforming the leaf spring.	✓	✓	✓	✓	✓	✓	✓					
a running toy comprising the suspension as claimed in claim 1		✓	✓									
wherein the leaf spring is detachable			✓									
wherein the leaf spring comprises a curved middle portion at which the leaf spring is held on the upper chassis				✓	✓	✓			✓			
wherein the upper chassis comprises a recess portion formed in the upper surface of the upper					✓	✓						

Claim Element	Claims 1-12 of the '011 Patent											
	1	2	3	4	5	6	7	8	9	10	11	12
chassis at a middle portion thereof, in which the curved middle portion of the leaf spring is held on the upper chassis												
wherein the curved middle portion of the leaf spring is sandwiched between the recess portion of the upper chassis and a shaft located on the upper chassis						✓						
wherein the leaf spring comprises metal or plastic							✓					
a biasing member which is elastically deformable vertically, and which contacts a contact portion of the wheel shaft at a middle of the wheel shaft								✓	✓	✓		
the wheel shaft being constructed to be movable vertically in a predetermined range, and to perform a seesaw motion by using the contact portion with the biasing member as a fulcrum								✓	✓	✓		
wherein the wheel shaft is pressed at the contact portion by using a biasing force which is caused by elastically deforming the biasing member, so that the right and left wheels are grounded to a road surface								✓	✓	✓		
a running toy comprising the suspension as claimed in claim 8									✓	✓		
the running toy in claim 9, wherein the biasing member is detachable										✓		
a leaf spring on a top of an upper chassis, supported at a middle portion between right and left wheels;											✓	✓
right and left wheel turning members on right and left vertical shafts inserted loosely into apertures of the upper chassis and a lower chassis, wherein top ends of the shafts project vertically through the upper chassis, biasing against a bottom of the leaf spring									✓		✓	✓
a tie rod connecting and forming a turning pair with each of the turning members											✓	✓

Claim Element	Claims 1-12 of the '011 Patent											
	1	2	3	4	5	6	7	8	9	10	11	12
a running toy comprising the suspension as claimed in claim 11												✓

IV. Statement Under 37 C.F.R. § 1.915(b)(3) Of Each Substantial New Question Of Patentability Based Upon the Cited Prior Art

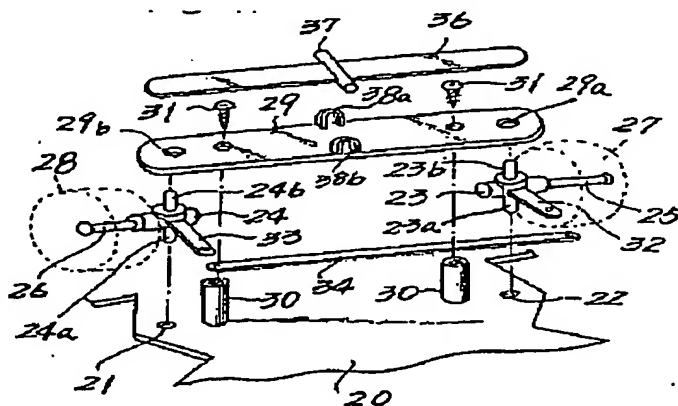
Claims 1-7 and 11-12 of the '011 patent are either anticipated and/or obvious under 35 U.S.C. § 102 and/or 35 U.S.C. § 103 in view of Minato '894 and/or Sakai '765 and/or Kumazawa '884. Minato '894, Sakai '765 and Kumazawa '884 were not cited during the prosecution of the '011 patent.

Moreover, claims 8-10 of the '011 patent are either anticipated and/or obvious under 35 U.S.C. § 102 and/or 35 U.S.C. § 103 in view of Perryman '490 and/or Allen '605. Perryman '490 was cited during prosecution of the '011 patent while Allen '605 was not cited during prosecution of the '011 patent.

Although the specific applicability of each of the above prior art references is set forth in detail in the claim charts attached as *Exhibit G* for Minato '894, *Exhibit H* for Sakai '765, *Exhibit I* for Kumazawa '884, and *Exhibit J* for both of Perryman '490 and Allen '605, the pertinency of each of the above prior art references is discussed in general below.

(1) Japanese Laid-Open Utility Model Application Number 1-172894 to Minato

Minato '894 discloses a steering device for a radio-controlled toy automobile. *Minato '894 at page 1¹*. Referring to Fig. 3 of Minato '894 shown below, right and left brackets 23, 24 are provided for turning right and left wheels 27, 28 about a vertical axis. *Minato '894 at page 6*.



¹ References are to the English language translation of Minato '894 included in Exhibit B.

The left and right brackets 23, 24 include corresponding pins 23a, 23b and 24a, 24b, respectively, which cooperate with a chassis of the toy automobile to support the left and right brackets 23, 24. *Minato '894 at page 6*. In particular, the pin 23a of the left bracket 23 fits into a pin hole 22 formed through a lower portion of the chassis, and the pin 23b fits into a pin hole 29a formed through a support member 29 disposed above the bracket 23. *Minato '894 at pages 6-7*. Similarly, the pin 24a of the right bracket 24 fits into a pin hole 21 formed through a lower portion of the chassis, and the pin 24b fits into a pin hole 29b formed through an opposite end of the support member 29 relative to the pin hole 29a. *Minato '894 at pages 6-7*. Accordingly, the left and right brackets 23, 24 can rotate and move in the vertical direction.

Minato '894 additionally discloses a tie rod 34 for connecting the left and right brackets 23, 24. *Minato '894 at page 7*. The tie rod 34 moves with the brackets 23, 24 during turning of the automobile, thereby forming a turning pair with the brackets. *Minato '894 at page 9*.

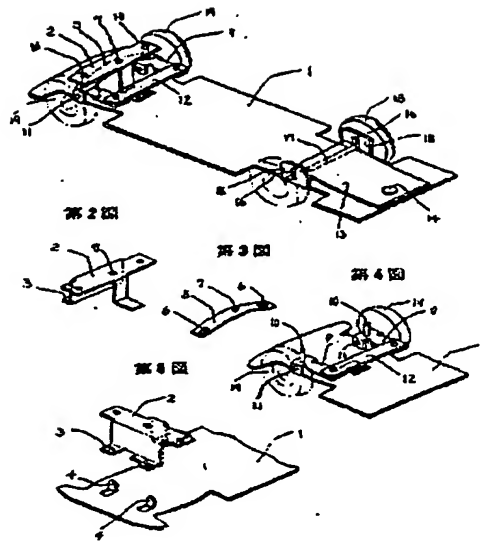
Moreover, Minato '894 discloses a see-saw member 36, which extends longitudinally along an upper surface of the support member 29 and is supported at an intermediate portion of the support member 29. *Minato '894 at page 7*. The ends of the see-saw member 36 abut against the distal ends of the upper pivot pins 23b, 24b of the left and right brackets 23, 24, respectively to prevent upward movement of the brackets. *Minato '894 at page 8*. Although the see-saw member 36 is described as being composed of synthetic resin, which may be rigid, Minato '894 also expressly states that the see-saw member 36 may be provided with elasticity. *Minato '894 at pages 7 and 11*.

Accordingly, Minato '894 raises a substantial new question of patentability of claims 1-7 and 11-12 of the '011 patent.

(2) Japanese Utility Model Application Number 38-16765 to Sakai

Sakai '765 discloses a suspension system for a toy car. *Sakai '765 at page 1²*. Referring to the Figures of Sakai '765 reproduced at the top of the following page, the toy car includes a pair of mounting bodies 9 having wheels 19 positioned thereon. *Sakai '765 at page 1*.

² References are to the English language translation of Sakai '765 included in Exhibit C.



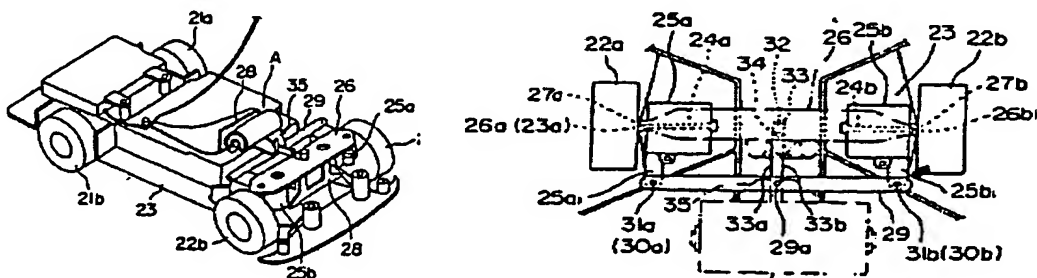
The mounting bodies 9 are connected via a connecting rod 12 such that the wheels 19 may move in response to each other during turning of the toy car. *Sakai '765 at page 1*. The mounting bodies 9 are mounted with shafts 10 between a platform 1 and a frame 2 in a manner that allows for up and down movement of the mounting bodies. *Sakai '765 at page 1*.

Moreover, an elastic thin sheet 5 is provided between the platform 1 and the frame 2 to cushion the up and down movement of the wheels 19. *Sakai '765 at page 1*.

Accordingly, Sakai '765 raises a substantial new question of patentability of claims 1-7 and 11-12 of the '011 patent.

(3) Japanese Patent Laid-Open Publication Number S61-002884 to Kumazawa

Kumazawa '884 discloses a suspension system for a toy car. *Kumazawa '884 at page 14*³. Referring to Figures 14 and 15 of Kumazawa '884 shown below, the toy car includes a pair of wheels 22a, 22b rotatably supported on a pair of bearing stands 25a, 25b, respectively. *Kumazawa '884 at page 14*.



³ References are to the English language translation of Kumazawa '884 included in Exhibit D.

The bearing stands 25a, 25b are each rotatably linked to a connecting rod 29, which is adapted to move in right and left directions to move the bearing stands, and accordingly, the wheels 22a, 22b.

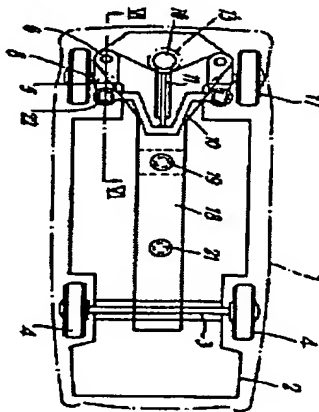
Kumazawa '884 at page 14. The upper lids of the bearing stands 25a, 25b are mated, via vertical shafts 27a, 27b, with axle holes 26a, 26b formed in end portions of an upper frame 26 of the toy car. *Kumazawa '884 at page 14.* The vertical shafts 27a, 27b (comprised of bolts) are also mated with axle holes 23a, 23b provided in a chassis 23. *Kumazawa '884 at page 14.* Accordingly, the bearing stands 25a, 25b are inserted between the chassis 23 and the upper frame 26.

A sheet spring is provided in the upper part of the upper frame 26 such that the vertical shafts 27a, 27b mated with the axle holes 26a, 26b are brought into contact with the spring, thereby creating a suspension. *Kumazawa '884 at page 14.* The upper frame 26 is fixed horizontally with the chassis 23 via fixing means such as screws that are attached to a support rod 28.

Accordingly, Kumazawa '884 raises a substantial new question of patentability of claims 1-7 and 11-12 of the '011 patent.

(4) Great Britain Patent Number 1095490 to Perryman and United States Patent Number 3,939,605 to Allen

Perryman '490 discloses a suspension for a toy car. *Perryman, page 2, col. 2, lines 122-123.* Referring to Fig. 5 of Perryman '490 shown below, an axle 3 is provided for connecting rotatable wheels 4. *Perryman '490, page 1, col. 2, lines 63-64.*



The toy car includes a resilient suspension in the form of a resilient strip 18, which may be formed from plastic or metal material. *Perryman '490, col. 2, lines 122-129.* The strip 18 is secured to the chassis 3 and bears against a central portion of the axle 3. *Perryman '490, col. 2, line 129 – col. 3, line 6.* The ends of the axle 3 are provided in slots such that the axle can move upwardly in the slots when the

resilient strip 18 biases against the central portion of the axle. *Perryman '490, col. 3, lines 7-14.*

Allen '605 is directed to accessories for toy cars, and discloses a toy vehicle having an axle 4 for connecting a pair of wheels 3. *Allen '605, col. 1, lines 5-10 and lines 55-63.* The toy vehicle may include suspension arrangements, which provide for resilient opposed movement of the wheels 3 relative to the chassis. *Allen '605, col. 1, lines 63-65.*

Accordingly, Perryman '490 and Allen '605, either alone or in combination, raise a substantial new question of patentability of claims 8-10 of the '011 patent.

V. Detailed Explanation of the Pertinency and Manner of Applying the Cited Prior Art To Claims 1-12 of the '011 Patent Under 37 C.F.R. § 1.915(b)(3)

Claims 1-12 of the '011 patent are set forth in detail on the attached claim charts (*Exhibits G, H, I and J*) and the limitations of claims 1-12 are compared to the pertinent cited prior art references. As the claim charts demonstrate, claims 1-12 of the '011 patent are invalid under 35 U.S.C. § 102 and/or 35 U.S.C. § 103 in view of the cited prior art references.

Specifically:

- (1) As demonstrated by the claim chart attached as Exhibit G, Minato '894 anticipates claims 1, 2, 4, 5, 11 and 12 under 35 U.S.C. § 102(b).
- (2) As demonstrated by the claim chart attached as Exhibit G, Minato '894 renders obvious claims 3, 6 and 7 under 35 U.S.C. § 103.
- (3) As demonstrated by the claim chart attached as Exhibit H, Minato '894 in view of Sakai '765 renders obvious claims 1-7 and 11-12 under 35 U.S.C. § 103.
- (4) As demonstrated by the claim chart attached as Exhibit I, Kumazawa '884 anticipates claims 1-2 and 11-12 under 35 U.S.C. § 102(b).
- (5) As demonstrated by the claim chart attached as Exhibit I, Kumazawa '884 renders obvious claims 3 and 6 under 35 U.S.C. § 103.
- (6) As demonstrated by the claim chart attached as Exhibit I, Minato '894 in view of Kumazawa '884 renders obvious claims 4 and 5 under 35 U.S.C. § 103.
- (7) As demonstrated by the claim chart attached as Exhibit J, Perryman '490 anticipates claims 8 and 9 under 35 U.S.C. § 102(b).
- (8) As demonstrated by the claim chart attached as Exhibit J, Perryman '490 renders obvious claim 10 under 35 U.S.C. § 103.
- (9) As demonstrated by the claim chart attached as Exhibit J, Allen '605 anticipates claims 8 and 9 under 35 U.S.C. § 102(b) or in the alternative renders obvious claims 8 and 9 under

35 U.S.C. § 103.

- (10) As demonstrated by the claim chart attached as Exhibit J, Allen '605 renders obvious claim 10 under 35 U.S.C. § 103.

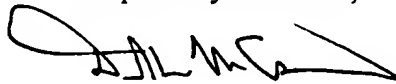
Accordingly, the foregoing references, either alone or in the above-described or other combinations, anticipate or render obvious claims 1-12 of the '011 patent under 35 U.S.C. § 102(b) and/or 35 U.S.C. § 103.

VI. Conclusion

For at least the reasons set forth above, it is clear that a new question of patentability is raised in connection with claims 1-12 by this Request for *Inter Partes* Reexamination, since claims 1-12 are anticipated and/or obvious under 35 U.S.C. § 102 and/or 35 U.S.C. § 103 in view of the cited prior art references. Therefore, it is requested that this request for reexamination be granted and claims 1-12 all be finally rejected.

Please direct all correspondence in this matter to the undersigned.

Respectfully submitted,



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Dated: 20 FEBRUARY 2004

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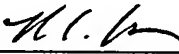
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DATE OF DEPOSIT: <u>2-20-2004</u>
<small>This paper and fee are being deposited with the U.S. Postal Service Express Mail Post Office to Addressee service under 37 CFR §1.10 on the date indicated above and is addressed to the Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450</small>
<u>Debbie Ludwig</u> Name of person mailing paper and fee
<u>Debbie Ludwig</u> Signature of person mailing paper and fee

CERTIFICATE OF SERVICE

The undersigned certifies that copies of the following:

(1) Request for *Inter Partes* Reexamination Transmittal Form

(2) Request for *Inter Partes* Reexamination including Exhibits A-J were served on William Herbert, Esq., Staas & Halsey, L.L.P., 1201 New York Avenue, N.W., Suite 700, Washington D.C. 20005, attorney of record for the assignee of the '011 patent in accordance with 37 C.F.R. § 1.915(b)(6) on the 26th day of February, 2004.



Richard V. Wells